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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,275	07/12/2005	Fiorenzo Draghetti	20022/40764	8911
4743 7590 09/10/2009 MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606-6357				
EXAMINER				
LOPEZ, CARLOS N				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
09/10/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/519,275

Applicant(s)

DRAGHETTI ET AL.

Examiner

CARLOS LOPEZ

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/2/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oesterling et al (US 5,135,008) in view of Draghetti et al (US 5,474,091). Oesterlin et al discloses a method of making filter-tipped cigarettes. The method comprises:

Feeding a first double cigarette tobacco articles (3) as shown in figure 1, with a standard pitch of 37.7mm (See Col. 14, lines 27);

the claimed feeding through a cutting station of the double cigarettes is done by conveyors 4 and cutting device 6 to thus create respective pair portions 7a and 7b;

the claimed spacing means for separating the respective portions is disclosed in bridging paragraph of Col. 8-9;

the claimed interposing a double cigarette is shown in figure 3 by the insertion of filter 16 to form the claimed second articles 22;

the claimed rolling a respective strip onto second articles to form a third article is depicted by elements 32 in figure 1 and strip 29 in figure 3;

the third articles as shown in figure 3 are cut by mechanism 37 shown in figure which forms the claimed two fourth articles;

the fourth articles are then placed onto a turnover unit deemed as conveyor 54.

The claimed first portion is deemed as the path formed by conveyors 4 and 8. The juncture of first portion with second portion would occur at the nip of conveyor 8 and 9 as shown in figure 1. Consequently, the path taken by the cigarettes after the 8/9 nip is deemed as the claimed second portion to thus obtain a second portion defined as the path downstream the 8/9 nip while on conveyor 9, and the path formed by conveyors 21, 31 and 34.

Oesterling reduces its pitch at the second portion while on conveyor 34, to thus provide a pitch reduction that occurs after the rolling of the strip 29 by conveyor 31. Osterling is silent making a pitch reduction prior to the rolling of the cigarette, meaning Osterling is silent making a pitch reduction on rollers 21 or 9.

However, Draghetti teaches that a pitch reduction should be made upstream the rolling station because during the rolling of the wrapper onto the double cigarette, if the speed of the cigarettes traveling along the path is too high then tobacco may spill from the open ends of the cigarette (See col 1, lines 27ff and Col. 2, lines 27ff). Following teachings of Draghetti, a person of ordinary skill in the art would be limited to slowing down the speed of the cigarette in Oesterling's device at either conveyors 31, 21, 9, 8 or 4 (essentially at 5 different points that are upstream of rolling station). Hence, in view of the limited possibility and reasonable expectation of success, it would have been obvious to a person of ordinary skill in the art to have placed the pitch reduction at any of the noted positions (wherein positions 4 and 8 are before interposing a double filter) in order to provide cigarettes at low speeds to prevent tobacco spill.

Furthermore, it has been held that "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product of not innovation but of ordinary skill and common sense." KSR International Co. v. Teleflex Inc., 550 U.S. 820 USPQ2d 1385 (2007).

Here, in view of the limited possibilities and the fact that the prior art teaches of pitch change to effectuate rolling speed prior to rolling the cigarettes, it would be deemed within the grasp of a person of ordinary skill in the art to try the limited alternatives with reasonable expectation of success (slower rolling speed).

Hence, the claimed modification of the prior art to now choose a specific alternative envisioned by the prior art is not a product of innovation but rather common sense by a person of ordinary skill in the art to try the limited alternatives to effectuate the same result.

As for claims 2-3, the claimed reduction is disclosed in Col. 2, lines 15ff.

As for claims 4-5, the claimed language does not provide any structural features. Here, one can easily designate the conveyor where the pitch reduction occurs and name it as the claimed juncture of the first and second portions. Hence, designating regions of a tobacco machines is merely an exercise in nomenclature.

As for claims 6-10, figure 3 of Oesterling discloses the claimed pitch reductions.

Response to Arguments

Applicant's arguments filed 6/2/09 have been fully considered but they are not persuasive. Applicant argues that 1) Draghetti's pitch reduction is done "immediately

upstream from the rolling drum"; and 2) that the instant invention is concerned with speed reduction at the insertion of the filter unlike Draghetti's focus of speed reduction during the rolling of the cigarette wrapper about the cigarette-filter tip assembly.

In regards to the first assertion, Draghetti address it in claim 1 providing for a pitch reduction "upstream the rolling station", at Col 2, lines 30 Draghetti providing that a "preferred embodiment..." is a pitch reduction done "upstream the rolling station", and in the abstract reciting that the pitch reduction is "immediately upstream from the rolling drum." Hence, as one can see, to characterize Draghetti as narrowly teaching that pitch reduction is done immediately is a mischaracterization of Draghetti and based on the language of claim 1 and the disclosed preferred embodiment of Draghetti. Hence, the argument on the basis that Draghetti should narrowly be construed to teach that pitch reduction is done immediately upstream the rolling station is unpersuasive.

What Draghetti teaches based both on the preferred disclosure and claim language is that the pitch reduction is done prior to rolling station in order to assure that tobacco does not exit from the wrapped cigarette. Hence, in view of the limited possibilities as set forth in the above rejection and with reasonable expectation of success, it would have been obvious to a person of ordinary skill in the art to have placed the pitch reduction at any of the noted positions in order to provide cigarettes at low speeds to prevent tobacco spill.

In response to applicant's argument 2) that the instant invention is concerned with speed reduction at the insertion of the filter, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior

art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Here, applicant's basis of patentability appears to be that it is concerned with speed reduction at the filter insertion section. However, such concern is not reflected in the manner the apparatus is structurally defined.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS LOPEZ whose telephone number is (571)272-1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos Lopez/

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Primary Examiner
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